

**Notice of Allowability**

Application No.

09/772,520

Examiner

Ashwin Mehta

Applicant(s)

GARING, FRANCIS L.

Art Unit

1638

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the BPAI decision of 31 March 2005 and telephone interview of 08 August, 2006.
2. ☒ The allowed claim(s) is/are 1-25 and 27-31.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                  |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>attached</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment  |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                         |
|   | 9. <input type="checkbox"/> Other _____  |

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### EXAMINER'S AMENDMENT

1. A request for information under 37 CFR 1.105 was mailed to Applicant on April 17, 2006, which asked for further information regarding the breeding history of corn variety I026458. However, upon further consideration, the breeding history in the specification was deemed sufficient, and Applicants are not required to respond to the request.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert Hanson on August 8, 2006.

The claims have been amended as follows:

3. [The population of seed of claim 2, further defined as an essentially homogeneous population of seed] An essentially homogeneous population of corn seeds consisting essentially of the inbred corn seed of claim 1.

4. [The population of seed of claim 2, further defined as essentially free from hybrid seed] A population of corn seeds consisting essentially of the inbred corn seed of claim 1, and essentially free from hybrid seed.

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14. An essentially homogeneous population of corn plants produced by growing a population of corn seeds consisting essentially of the seed of the corn variety I026458, wherein a sample of the seed of the corn variety I026458 was deposited under ATCC Accession No. PTA-3228.

In claim 15, line 1, the recitation, "capable of" was deleted.

17. A tissue culture of regenerable cells of a plant of corn variety 1026458, wherein the tissue [is capable of regenerating] regenerates plants [capable of] expressing all the physiological and morphological characteristics of the corn variety I026458, wherein a sample of the seed of the corn variety I0026458 was deposited under ATCC Accession No. PTA-3228.

In claim 20, lines 1-2, the recitation, "is capable of expressing" was replaced with --expresses--.

24. F1 hybrid [Hybrid] corn seed produced by the process of claim 22 [23].

25. An F1 [A] hybrid corn plant produced by growing a seed produced by the process of claim 22 [23].

Claim 26 was cancelled because it is duplicative.

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27. The corn plant of claim 5, [further defined as having] comprising a genome further comprising a single locus conversion.

28. The corn plant of claim 27, wherein the single locus conversion was conferred by a transgene [stably inserted into a corn genome by transformation].

30. The corn plant of claim 27, wherein the locus confers a trait selected from the group consisting of herbicide tolerance; insect resistance; resistance to bacterial, fungal, nematode or viral disease; [yield enhancement;] waxy starch; [improved nutritional quality; enhanced yield stability;] and male sterility [and restoration of male fertility].

3. Claims 1-25 and 27-31 are allowed.

4. The following is an examiner's statement of reasons for allowance: Applicants have developed an inbred corn plant named "I026458," seed of which have been deposited with the ATCC in accordance with 37 CFR 1.801-1.809. I026458 is deemed free of the prior art, given the failure of the prior art to teach or fairly suggest corn plants or seeds that possess the same combination of traits as I026458. The claimed F1 hybrid seeds and plants are distinguished from plants in the prior art since they have the same haplotype as their I026458 parent plant. All claims drawn to hybrid plants or seeds refer to F1 hybrids (BPAI decision, footnote on page 5).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Contact Information***

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at 571-272-0975. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

October 5, 2006



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